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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 15  
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Zelby Industries, L.L.C.

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Serial No. 75/694,109

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Lawrence R. Robins for Zelby Industries, L.L.C.

Gineen M. Bresso, Trademark Examining Attorney, Law Office  
111, (Kevin Peska, Acting Managing Attorney).

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Before Cissel, Hanak and Quinn, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Zelby Industries, L.L.C. seeks to register in typed drawing form SURF CARD for "credit card and debit card services" (Class 36) and "providing an on-line link to commercial, retail and informational web sites of other companies and individuals; providing search engines for obtaining data on a global computer network" (Class 42). The intent-to-use application was filed on April 30, 1999. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use CARD apart from the mark in its entirety.

Ser. No. 75/694,109

The Examining Attorney has refused registration pursuant to Section 2(d) of the Trademark Act on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark THE SURFER'S CARD, previously registered in typed drawing form for "financial services, namely, credit card and debit card services, including providing consumers with credit in connection with the sale of merchandise and services." Registration No. 2,122,520. This registration issued on the Supplemental Register on December 16, 1997 with a disclaimer of the exclusive right to use CARD apart from the mark in its entirety.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Applicant has filed a multiclass application. Thus, this Board is obligated to make two separate inquiries into the issue of likelihood of confusion, one involving applicant's Class 36 services and one involving applicant's Class 42 services.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the services.

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the essential characteristics of the [services] and differences in the marks.").

We will consider first applicant's Class 36 services (credit card and debit card services) and registrant's services (financial services, namely, credit card and debit card services, including providing consumers with credit in connection with the sale of merchandise and services). Despite differences in terminology, applicant's Class 36 services are legally identical to registrant's services. The fact that registrant has included the words "financial services" and "including providing consumers with credit in connection with the sale of merchandise and services" in no way limits registrant's "credit card and debit card services," the identical services for which applicant seeks

to register its mark.

Considering next the marks, we note at the outset that when the services are legally identical, as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

Century 21 Real Estate Corp. v. Century Life of America,  
970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Obviously, both marks include the very highly descriptive if not generic term CARD. The word THE in the registered mark has very little source identifying significance. As applicant candidly acknowledges at page 8 of its brief, "the dominant element common to both applicant's and registrant's marks is the word SURF." To be more precise, while applicant's mark includes the word SURF whereas the registered mark includes the word SURFER'S, these two words are extremely similar in terms of both visual appearance and pronunciation. Moreover, in terms of connotation, while the word SURF refers to the act of navigating waves or the Internet, and while the word SURFER'S refers to a person who surfs in the possessive form, nevertheless, the two words have at least somewhat similar connotations.

In sum, given the fact that applicant's Class 36 services and registrant's services are legally identical, and the fact that the two marks are very similar in terms of visual appearance and pronunciation and are at least somewhat similar in terms of connotation, we find that there exists a likelihood of confusion, and accordingly affirm the refusal to register with regard to applicant's Class 36 services.

Before concluding our discussion of applicant's Class 36 services, two final comments are in order. First, applicant has made of record evidence demonstrating that registrant's THE SURFER'S CARD is an affinity card designed for individuals who ride surfboards. Registrant's card affords surfers (of the wave variety) discounts at surf shops and the ability to fly their boards for free on participating airlines. Applicant then goes on to argue at page 9 of its brief that its SURF CARD does not bring to mind a water sport, but rather brings to mind "navigating the Internet."

There is a fundamental flaw in applicant's reasoning. In Board proceedings "the question of likelihood of

confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Both applicant's Class 36 services as set forth in its application and registrant's services as set forth in the registration encompass credit and debit card services of all types. Thus, for the purposes of our analysis, applicant's Class 36 services are legally identical to registrant's services. The fact that in actuality there may be some slight differences in applicant's and registrant's credit and debit card services is of no consequence.

Second, applicant has made of record third-party registrations of marks containing the word SURF. These third-party registrations are of no probative value for two reasons. First, none of the services of these third-party registrations encompass credit card and debit card services, or services even related to credit and debit card

services. Second, in any event, even if the third-party registrations containing the word SURF were for services identical to or at least somewhat related to debit and credit card services, these third-party registrations would not demonstrate that the marks in question are in actual use, much less would they demonstrate that the extent of use of these third-party marks has been so great that consumers have been conditioned to distinguish between various SURF marks. Smith Brothers Manufacturing v. Stone Manufacturing, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973).

We turn now to a consideration of the relationship, if any, between applicant's Class 42 services (providing an on-line link to commercial, retail and informational web sites of other companies and individuals; providing search engines for obtaining data on a global computer network) and registrant's credit card and debit card services. To cut to the quick, the prior Examining Attorney made of record absolutely no evidence showing that there is any relationship whatsoever between applicant's Class 42 services and registrant's credit card and debit card

services. Moreover, in her brief, the current Examining Attorney never even argued that there was any relationship between applicant's Class 42 services and registrant's credit card and debit card services.

Given this complete failure of proof to show any relationship between applicant's Class 42 services and registrant's credit card and debit card services, we are compelled to find that there exists no likelihood of confusion with regard to these two types of services.

Decision: The refusal to register with regard to applicant's Class 36 services is affirmed. The refusal to register with regard to applicant's Class 42 services is reversed.



